

Appl. No. 09/538,792

Amdt. Dated April 21, 2004

Reply to Office Action of November 21, 2003

REMARKS

Reconsideration of the application is requested.

Applicants appreciatively acknowledge the Examiner's verification and entry of applicants' timely filed RCE and amendment.

Claims 1-14 are now in the application. Claim 1 has been amended. Claims 13 and 14 have been added.

In "Claim Rejections - 35 USC § 102" item 3 on page 3 of the above-identified Office Action, claims 1-12 have been rejected as being fully anticipated by U.S. Patent No. *Picard, et al.* to 6,233,318 (hereinafter **PICARD**) under 35 U.S.C. § 102(e).

The rejection has been noted and the claims have been amended in an effort to even more clearly define the invention of the instant application. Support for the changes is found, among other places, in the paragraph bridging pages 3 and 4 of the specification of the instant application.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful. Claim 1 as amended calls for, *inter alia*, a method

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of notifying a subscriber of a plurality of message services
of a message including:

indicating, with each of the plurality of message
services, to a **common notification server** a presence of
a new message for a subscriber **on** the respective
message service;

selecting, by the subscriber, at least one terminal
from a plurality of terminals of the message services;

transmitting a notification, with the notification
server, to the at least one selected terminal, **in
contrast to transmitting the message**, the transmitted
notification **indicating** that **a new message is present**
and **in which message service** the new message is
present.

The **PICARD** reference discloses a unified messaging system
that provides a multimedia mailbox, allowing a subscriber to
access stored multimedia messages, such as voicemail
messages, facsimile messages, combined voice and facsimile
messages and video messages, over the internet or telephone.
For text type messages, such as facsimile and email, the
system described in **PICARD** converts the text into speech and
plays the speech to the telephone user. The **PICARD** system
also allows a personal computer user to view text type
messages and to stream voice and video messages. As
indicated in FIG. 4 of **PICARD** the messages are transmitted

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from various message services to the integrated messaging system. Once the **PICARD** integrated messaging system has received and converted the message, notifications based on where and how the user accesses the **PICARD** system may be generated.

One of the capabilities that **PICARD** provides, but is allegedly not available to systems using "a single-media mailbox" is:

- c. Notification mechanism(s) which can be used to alert the user of the deposit of any type of message.
 - d. The ability to access the mailbox through a variety of commonly-available mailbox access terminals (PC, DTMF phone, etc.), without special equipment, and with, as far as practicable, logically the same capabilities for all terminal types
- (col. 3, lines 49-56)

Applicants respectfully note that the "notification mechanism(s)" are used **only** if the message is deposited into the "fully integrated mailbox" to alert the user "of the **deposit of any type of message**" into the mailbox.

In an effort to clarify the type of mailboxes used and potential access terminals available in **PICARD**, the **PICARD** reference later explains:

Although it is possible to have a mailbox which is integrated with respect to multiple message types but which can only be accessed through a single type of terminal (e.g., e-mail systems using MIME), a fully integrated mailbox is preferably accessible from several types of terminals and pathways, to maximize the subscriber's ability to access his messages in various

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circumstances. The following terminal types are provided by the present invention: a. Conventional DTMF telephone handset; and b. Personal Computer (PC). (emphasis added) (col. 4, lines 4-14)

Applicants respectfully assert that regardless, of whether **PICARD** is used both to show one mailbox holding multiple message types and to show one integrated mailbox accessible from several terminals to maximize a subscriber's ability to access messages, **PICARD** does not describe the method claimed in the instant application. Namely, that "a common notification server" receives an indication of a new message from of the message services and transmits "a notification ... to at least one selected terminal ... indicating a new message ... and in which message service" as recited in claim 1 of the instant application.

Specifically, **PICARD** uses "a message server" or "integrated mailbox" not "a notification server" to transmit notifications. One of the primary differences being that the notification server as claimed in the instant application does not have to receive the entire "new message" and following conversion of the received new message use the available notification mechanisms described in **PICARD** (col. 11, lines 37-50). Rather the instant application claims that each of the message services indicate "a presence of a new message for a subscriber on the respective message service" to "a common notification server" as recited in claim 1. The

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notification server of the instant application does not change the new message as potentially required in **PICARD**.

Moreover, the claimed indication is not of a presence of a new message "on" the message server or IMS of **PICARD**. When these deficiencies in **PICARD** are combined with the similarly missing limitation from claim 1 of the instant application that the notification server transmit "a notification" that indicates "a new message is present" and "which message service" holds the new message, **PICARD** clearly does not anticipate claim 1 of the instant application.

In fact one of the various embodiments described in **PICARD** indicates that "some of the integrated message systems may have **no notification capability**," and that only the "virtual IMS" provides that "one MS does not store all messages" (col. 11, line 60 to col. 12, line 10). However, upon further review one determines that in the virtual IMS there may be multiple "MSs" that each receives deposits of some of the messages. In this regard, **PICARD** also clarifies that even the virtual IMS "may require non-standard mechanisms, since most MSs are not designed to accept notifications."

Moreover, the potentially required MS modification "defeats much of the purpose of a virtual IMS." As such, **PICARD** actually teaches away from the principles and concepts of

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using "a common notification server" and "transmitting a notification" from the notification server to "at least one selected terminal" as recited in claim 1 of the instant application.

More specifically, **PICARD** teaches that multiple message types through a message server (see e.g., email MIME system) can be accessed from a single terminal and that a "fully integrated mailbox" including multiple message types can be accessed from "several types" of terminals, but **PICARD** does not teach or suggest that a notification, originating from a notification server and based on an indicated presence of a new message on a message service, can be transmitted to at least one subscriber selected terminal.

Turning now to the alleged evidences of "notification" in **PICARD**, it is clear that these references are all referring to notification of messages deposited in a central or integrated message mailbox. For example, col. 2, line 30 states, "It is a further object of the present invention to provide message waiting/urgent notifiers when new or urgent messages are deposited in the mailbox or the message status changes by a simultaneous different connection into the mailbox such as when a mailbox is accessed by computer and while the computer is logged into the mailbox an access via a

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telephone interface **deletes a message.**" The second more detailed description of the notification mechanisms available through **PICARD** can be found in col. 11, lines 37-50. But the disclosure description is limited to messages that have already been successfully converted and/or deposited into the common or integrated mailbox, "so the subscriber need only access the system when messages exist" (col. 11, lines 38-39). The instant application does not require the messages to be "on" or "deposited with" the notification server, in fact the notification server of the instant application sends a "transmitted notification indicating that a new message is present **and in which message service the new message is present**" as recited in claim 1. Thus, the instant application notifies of a new message and tells the subscriber where the message can be found. In **PICARD** it is unnecessary to tell the subscriber where the new message is, because they are all on/in the integrated mailbox!

Additionally, the terminal type (telephone or computer) **being used** by the subscriber **not** "where" (voicemail, email, etc.) the message can be found **varies the type of notification in PICARD**. Thus, exemplary notifications according to one embodiment of the instant application using a phone terminal with a message LED could include: an LED flashing "four times quickly" or "turning green" to indicate that a voicemail

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message can be retrieved from a subscribers work number and flashing "twice slowly" or "turning amber" for an urgent work email. In contrast, the same LED in **PICARD** would only need to light up since both the voicemail and urgent email messages would be in the same mailbox in **PICARD**.

Along these lines, the instant application as claimed does not require the message data type to be deposited or converted only the presence of a new message is reported, a significant further contrast to **PICARD**. More specifically, **PICARD** explains:

Two situations for data type conversion can arise: when a subscriber's terminal type will not accept the stored message format, and upon user request. An intermediate situation is when a subscriber requests delivery or forwarding of the message to a system or terminal, other than the one he is using, which does not support the data type. Most conversions are implicit from the message type and the destination, but it may be preferable for a subscriber to explicitly request conversion (e.g.) of a facsimile message to text for forwarding to an Internet address, even though the message could have been sent as a MIME facsimile message.

By changing the data type, **PICARD** runs the risk of losing data and even worse changing the message. Moreover, to accomplish the conversion of the various message types (i.e. converting text type messages into speech), **PICARD** requires significantly more overhead than the instant application.

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As indicated in FIG. 1 and FIG. 2 of the instant application, the notification server of the instant application receives various "new message" indicators from the various message services and transmits a notification to at least one selected terminal. The method of the instant application does not require the overhead necessary to convert messages, nor does the method of the instant application risk changing the message as **PICARD**.

Clearly, **PICARD** teaches away from using only "a common notification server," using "at least one selected terminal" to receive notification, and instead requires that the system provide **access** to integrated **messages**. Nor does **PICARD** transmit "a notification" having both an indication that a new message is present and the location/message service where the new message is found as recited in claim 1 of the instant application.

PICARD also does not disclose, "selecting, by the subscriber, at least one terminal from a plurality of terminals of the message services" as recited in claim 1 of the instant application. In the invention of the instant application, the subscriber can select the terminal to which the notification is to be sent. In **PICARD** the subscriber **must** access a new and different message system. Even if the

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required terminal in **PICARD** does offer a "fully integrated mailbox" this is not the same as allowing the subscriber to select "at least one terminal" as recited in claim 1.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claim 1. Claim 1 is, therefore, believed to be patentable over the art. The dependent claims are believed to be patentable as well because they all are ultimately dependent on claim 1.

In view of the foregoing, reconsideration and allowance of claims 1-14 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel would appreciate receiving a telephone call so that, if possible, patentable language can be worked out.

Petition for extension is herewith made. The extension fee for response within a period of two months pursuant to Section 1.136(a) in the amount of \$420.00 in accordance with Section 1.17 is enclosed herewith.

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If an extension of time is required, petition for extension is herewith made. Any extension fee associated therewith should be charged to the Deposit Account of Lerner and Greenberg, P.A., No. 12-1099.

Please charge any other fees that might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Lerner and Greenberg, P.A., No. 12-1099.

Respectfully submitted,


For Applicants

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KHF:cgm

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